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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,156	08/21/2001	David Roth Rigney		7387

7590  
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EXAMINER

LY, CHEYNE D

ART UNIT	PAPER NUMBER
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2168

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/934,156

Applicant(s)

RIGNEY, DAVID ROTH

Examiner

Cheyne D. Ly

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2168

### **DETAILED ACTION**

1. The art unit designated for this application has changed. Applicants(s) are hereby informed that future correspondence should be directed to Art Unit 2168.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2005 has been entered.
3. Applicants' arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
4. The cancellation of claims 2-6 has been acknowledged and the proposed amendment to the specification has been entered.
5. Claim 1 is examined on the merits.

### **OBJECTIONS**

6. It is noted that the amendment to the specification, filed March 21, 2005, has not addressed the below identified hyperlinks.
7. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (page 41, line 17, page 62, lines 8 and 11, and page 63,

line 4). Applicant(s) is/are required to delete the embedded hyperlink and/or other form of browser-executable code, or inactivate the hyperlink. See MPEP § 608.01.

8. The attempt to incorporate subject matter into this application by reference to “the bow software kit...(version 1999.11.22), and which was downloaded from the Web site...” (page 17, lines 5-8) is ineffective because the software kit has been reasonably interpreted as being directed to the essential subject matter, the computer program Rainbow, as required by claim 1, step (e), last line. 37 CFR 1.57 specifies that “[e]ssential material may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication...” Which is not the case for the instant Application because the incorporation by reference is from a Web site.

#### **Claim Rejections - 35 USC § 112**

9. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. NEW MATTER REJECTION.
10. The proposed amendment of “the system attaches...” (claim 1, lines 4-5) has not been found in the instant specification. It is noted that the instant specification discloses “words or phrases in the text that are most uniquely associated...to each cluster” (page 11, last paragraph). The instant disclosure does not provide written basis for the proposed amendment.

Art Unit: 2168

11. Claim 1, steps (c) and (d), recites limitations directed to “a cluster with a superset...,” which has not been found in the instant specification.

### **CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. The relative limitation “superset,” claim 1, steps (c) and (d), is vague and indefinite due to lacking any metes and bounds as to what suitability characteristic is being evaluated in order to compare to less suitable attributes so as to evaluate what is “superset”.

### **CONCLUSION**

15. It is noted that claimed invention is free of any prior art.
16. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance.

Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within

Art Unit: 2168

5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

17. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is (703) 872-9306.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached on (571) 272-4146.

C. Dune Ly /*CDL*  
Patent Examiner  
11/1/05

*[Handwritten Signature]*  
JEFFREY GAFFIN  
SUPERVISOR  
EXAMINER  
11/1/05